

Serial No.: 10/673,207  
Docket No.: 101-1004  
Amendment dated January 25, 2010  
Reply to the Final Office Action of November 24, 2009

## **REMARKS**

### **Introduction**

Applicants note with appreciation the Examiner's indication that each of the references cited in the Information Disclosure Statement of October 27, 2005 has been considered.

Upon entry of the foregoing amendment, claims 1, 6, 7, 9-34, and 36-56 are pending in the application. Claims 9 -13 have been amended. Claims 43-56 have been newly added. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are respectfully requested.

### **Rejection under 35 USC §112**

Claims 1 and 6 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Further, claim 7 has been rejected under 35 U.S.C. §112, first paragraph due to its dependency on claim 1. Applicants respectfully traverse this rejection for at least the following reasons.

In particular, the Examiner states on page 2 of the Office Action mailed November 24, 2009 that "the applicant fails to describe how a user can select to connect either the storage to the scanner or the storage to the printer." Applicants respectfully submit that, as explained in paragraphs [0012], [0029], and [0051] of Applicants' specification, the storage is detachable from the scanner or printer, hence why the user can selectively connect the storage to the scanner or printer. In other words, "the first storage unit 10 is selectively detached from the first scanning unit 16 and attached to the printing unit 18 or detached from the printing unit 18 and attached to the first scanning unit 16." (See [0029] and [0051] of Applicants' specification) Thus, Applicants specification clearly describes how the storage is selectively connected to either the scanner or printer. Therefore, Applicants respectfully submit that the rejection of claims 1, 6, and 7 are improper. Accordingly, withdrawal of this rejection is earnestly solicited.

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### **Rejection under 35 USC §112**

Claims 9 and 13 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse this rejection for at least the following reasons.

In particular, the Examiner states on page 3 of the Office Action mailed November 24, 2009 that “the specification says that the scanned result is read from the storage unit. Since there is a difference between reading from the storage unit and directly reading from, the applicant does not have support for the limitation that the scanned result is directly read from the storage unit,” as recited in claims 9 and 13. (Emphasis in the original)

However, Applicants respectfully submit that the specification does in fact support the recitation that “the unit prints the scanned result directly read from the storage units,” as presently recited. In particular, the FIGS. 1A, 1B, and 3 each illustrate a scanning unit and/or a printing unit directly connected to a storage unit via a connector. A connection between a storage unit and the scanning and/or printing unit is naturally necessary to connect the two devices. Further, no device other than a connector is illustrated between the storage unit and the scanning and/or printing unit. (See Applicants’ FIGS. 1A, 1B, and 3) Therefore, Applicants respectfully submit that the specification does in fact support the recitation that “the unit prints the scanned result directly read from the storage units,” as presently recited in claims 9 and 13. Accordingly, withdrawal of this rejection is earnestly solicited.

### **Rejection under 35 USC §112**

Claims 9 and 13 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10, 11, and 12 are also rejected under 35 U.S.C. §112, second paragraph due to their dependency on claim 9. Applicants respectfully traverse this rejection for at least the following reasons.

In particular, the Examiner states on page 3 of the Office Action mailed November 24, 2009 that “it is not clear to the examiner whether the image forming apparatus comprises of (a scanning and a printing unit) or ((a scanning unit) or (a printing unit)).” Applicants have

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amended claims 9-13 to address the Examiner's concerns. Accordingly, withdrawal of this rejection of claims 9-13 is earnestly solicited.

### **Rejection under 35 USC §102**

Claims 1, 6, 7, 9, 10-13 and 39-42 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2002/114002 to Mitsubori. Applicants respectfully traverse this rejection for at least the following reasons.

#### **Independent claims 1, 6, and 39**

Applicants respectfully submit that Mitsubori fails to teach or disclose each limitation as recited in the independent claims. In particular, the Examiner alleges that a printer 40, scanner 12, and web server 20 in Mitsubori could be interpreted to read on Applicants' printing unit, scanning unit, and storage unit, respectively. However, Applicants respectfully submit that Mitsubori fails to teach or disclose, among other things, "wherein the storage unit is selectively connected to one of the scanning unit and the printing unit," as recited in independent claim 1 and 6, and similarly recited in independent claim 39.

On pages 5 and 6 of the Office Action mailed November 24, 2009, the Examiner states that "fig. 8 shows clearly that printers 40a and scanner 12 are selectively connected to server 20 since any of the scanners and printer can be disconnected and connected as well." However, Applicants respectfully submit that the Mitsubori web server 20 is not "selectively connected," as recited, to the printer 40 since the Mitsubori web server 20 cannot select to connect to printer 40 without also being connected to scanner 12. In other words, FIG. 8 of Mitsubori illustrates that the web server 20 must connect to scanner 12 in order to connect with printer 40. Therefore, the Mitsubori web server 20 cannot "selectively connect to one of the scanning unit and the printing unit" since both the printer 40 and scanner 12 must be in constant connection with each other in order for the web server 20 to connect with the printer 40. Thus, the Mitsubori web server 20 is simply connected to both scanner 12 and printer 40, without the ability to select a connection solely with either the scanner 12 or printer 40.

On the other hand, Applicants storage unit has the ability to "selectively connect" between the scanning unit and the printing unit since, as explained in paragraphs [0012], [0029],

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and [0051] of Applicants' specification. Applicants' storage is detachable from the scanner or printer, hence why the user can selectively connect the storage to either the scanner or printer or both. In other words, "the first storage unit 10 is selectively detached from the first scanning unit 16 and attached to the printing unit 18 or detached from the printing unit 18 and attached to the first scanning unit 16." (See [0029] and [0051] of Applicants' specification) (Emphasis added) Further, unlike Mitsubori, Applicants' printer and scanner can each directly connect to the storage unit, thus providing the storage unit the ability to select a connection with the printer without connecting to the scanner. Therefore, Applicants respectfully submit that Mitsubori fails to teach or disclose, among other things, "wherein the storage unit is selectively connected to one of the scanning unit and the printing unit," as recited in independent claim 1 and 6, and similarly recited in independent claim 39. Accordingly, withdrawal of this rejection and allowance of independent claims 1, 6, and 39 are earnestly solicited.

#### Independent claims 9 and 13

Applicants respectfully submit that Mitsubori fails to teach or disclose each limitation as recited in the independent claims. In particular, the Examiner alleges that a printer 40, scanner 12, and web server 20 in Mitsubori could be interpreted to read on Applicants' printing unit, scanning unit, and storage unit, respectively. However, Applicants respectfully submit that Mitsubori fails to teach or disclose, among other things, "wherein the unit prints the scanned result directly read from the storage units," as recited in independent claim 9, and similarly recited in independent claim 13. (Emphasis added)

On page 9 of the Office Action mailed November 24, 2009, the Examiner highlights FIG. 8 of Mitsubori with regard to claim 9, wherein the Examiner states that "Fig. 8 shows clearly a connection between Printer 40 and server 20." However, as illustrated in FIG. 8 of Mitsubori and unlike Applicants' invention, the web server 20 is not directly connected to the printer 40 since the scanner 12 and communication network 30 are in between the web server 20 and printer 40. Thus, the Mitsubori printer 40 cannot print "the scanned result directly read from the storage units," as recited in Applicants' independent claims 9 and 13.

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On the other hand, Applicants recite a "scanned result directly read from the storage units." (Emphasis added) Hence, the unit must be directly connected to the storage unit in order for the "scanned result" to be "directly read from the storage units," as recited. Therefore, Applicants respectfully submit that Mitsubori fails to teach or disclose, among other things, "wherein the unit prints the scanned result directly read from the storage units," as recited in independent claim 9, and similarly recited in independent claim 13. Accordingly, withdrawal of this rejection and allowance of independent claims 9 and 13 are earnestly solicited.

#### Dependent claims 10-12 and 40-42

Although the Examiner lists claim 7 as rejected under Mitsubori on page 4 of the Office Action mailed November 24, 2009, Applicants respectfully submit that this was a typo since a detailed rejection of claim 7 is stated under the §103(a) rejection of claim 7 on pages 12 and 13 of the Office Action. However, clarification is requested.

For at least the reason that claims 10-12 depend from independent claim 9 and claims 40-42 depend from independent claim 39, which are allowable as pointed out above, and therefore contain all of the features recited therein, dependent claims 10-12 and 40-42 are also allowable over Mitsubori. Accordingly, withdrawal of the rejection and allowance of claims 10-12 and 40-42 are earnestly solicited.

#### **Rejection under 35 USC §103**

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Mitsubori in view of U.S. Patent No. 7,019,869 to Chen. Applicants respectfully traverse this rejection for at least the following reasons.

For at least the reason that claim 7 depends from independent claim 1, which is allowable as pointed out above, and therefore contains all of the features recited therein, dependent claim 7 is also allowable over Mitsubori and Chen, whether taken alone or in combination with one another. Accordingly, withdrawal of the rejection and allowance of claim 7 are earnestly solicited.

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### **New Claims**

New claims 43-56 have been added. No new matter is being added, and support for new claims 43-56 can be found throughout the specification, such as, for example, at paragraphs [0029] through [0080]. Applicants respectfully submit that the prior art of record does not teach or disclose all limitations of new claims 43-56. In particular, the cited prior art does not show, for example, Applicants' "a control unit for detecting an attachment state of the external storage unit with respect to the input/output port and for controlling storing of the scanned data according to the detected attachment state of the external storage unit such that when it is determined that the external storage unit is attached to the input/output port, the control unit stores the scanned data in the external storage unit," as recited in new claim 43. Accordingly, claims 43-56 are patentably distinguishable over the cited prior art and allowance of claims 43-56 is earnestly solicited.

### **Conclusion**

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.


If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 502827.

Respectfully submitted,

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